

TRANSMITTAL OF APPEAL BRIEFDocket No.
VID-01702/29

In re Application of: Barry H. Schwab et al.

Application No.	Filing Date	Examiner	Group Art Unit
09/877,597-Conf. #1591	June 8, 2001	L. R. Nash	2153

Invention: SYSTEM FOR TRANSFERRING DESKTOP COMPUTER CONFIGURATION

TO THE COMMISSIONER OF PATENTS:Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: May 24, 2007.The fee for filing this Appeal Brief is \$ 250.00.☐ Large Entity ☒ Small Entity☐ A petition for extension of time is also enclosed.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Schwab et al.

Serial No.: 09/877,597

Group No.: 2153

Filed: June 8, 2001

Examiner: L. Nash

For: SYSTEM FOR TRANSFERRING DESKTOP COMPUTER CONFIGURATION

APPELLANTS' BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real parties and interests in this case are Barry H. Schwab and John G. Posa, individuals, Applicants and Appellants.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 11 claims. Claim 2 has been canceled. Claims 1 and 3-11 are pending, rejected and under appeal. Claim 1 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a method of transferring user preferences from one computer to another, comprising the steps of providing a transportable data storage medium recording on the transportable data storage medium, at a first computer, unique information relating to a particularly user's computer configuration preferences, including information relating to the user's preferred desktop graphical interface ; receiving the transportable data storage medium at a second computer; and at least temporarily configuring the second computer in accordance with the information stored on the transportable medium. (See, for example, Specification, page 3, line 9 to page 5, line 6; Figure 1).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 1 and 3-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,654,797 to Kamper in view of U.S. Patent No. 6,512,526 to McGlothlin et al.

B. The rejection of claim 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,654,797 to Kamper and U.S. Patent No. 6,512,526 to McGlothlin et al., as applied to claim 1, further in view of U.S. Patent No. 6,029,196 to Lenz.

VII. Argument

A. Claims 1 and 3-10

Appellants' independent claim 1 resides in a method of transferring user preferences from one computer to another. The claimed method includes the steps of recording, on a transportable data storage medium, unique information relating to a particular user's computer configuration preferences, including information relating to the user's preferred desktop graphical interface, and at least temporarily configuring a computer in accordance with the information stored on the transportable medium.

Claims 1 and 3-10 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,654,797 to Kamper in view of U.S. Patent No. 6,512,526 to McGlothlin et al. The Kamper Patent is entitled "Apparatus And Methods For Server Configuration Using A Removable Storage Device." The Examiner concedes that "Kamper fails to expressly disclose that the configuration data is unique information relating to a particular user's computer configuration preferences, including information

relating to the user's preferred desktop graphical interface," but argues that "these were well known features in the art at the time of the invention, as further evidenced by McGlothlin. Therefore, it would have been obvious to accordingly modify the method as disclosed by Kamper, for one of ordinary skill in the art." (Final OA, p.4) For the following reasons, Appellants respectfully disagree.

The nature of the data that is uploaded according to Kamper is limited to configuring a server computer "for use in a network." Indeed, the scope of this data is defined in this way: "The configuration data may include, for example, the IP address of the server, the hostname, the netmask, the gateway, domain, and nameserver information for the server 118." (Kamper; 4:10-13): Every example cited is for data related to networking; none of the various embodiments disclosed in Kamper in any way suggest the use of a removable storage device to store user data.

McGlothlin et al., on the other hand, describe a method for configuring a PC with application programs specified by different users. The system is designed for an operating system like Windows, and allows for a user to select programs to be loaded, which results in a particular desktop configuration.

The process of McGlothlin is designed for configuring a new PC, or at least the first time a PC is used by a particular user. McGlothlin specifically excludes multiple runs of the configuration process. There is no mention in McGlothlin of a "transportable data storage medium." While there are mentions of "nonvolatile storage," these are references to the internal hard disk drive of the PC, not a removable or transportable data storage medium. Since there is no separate transportable data storage medium in McGlothlin, all software loaded during the configuration process must already reside on the hard disk drive of the PC that is to be configured.

The Examiner's more specific argument as why the Kamper/McGlothlin combination is justified is found toward the bottom of page 4, Final OA. "One of ordinary skill in the art would have been motivated to implement this modification so as further [sic] allow configuration of the computing devices (i.e., including the graphical user interface) to be based on the preferences and expertise of different users, thereby increasing ease of use (Kamper column 5, line 65-column 6, line 5)."

The Examiner's argument that Kamper should be modified to receive "configuration of the computing devices (i.e., including the graphical user interface)" is flawed. None of the various embodiments disclosed in Kamper in any way suggest the use of a removable storage device to store

data to be used for configuration of a particular graphical user interface (GUI). In fact, Kamper teaches away from even employing a display device for configuration purposes, let alone a GUI:

“In the prior art, when a suite of new server machines is installed, setup, and administered, it was necessary to attach a terminal, keyboard, and/or mouse to each server machine in turn, moving these devices between the servers. This can be very awkward and time consuming, since this requires connection of three different ports sing [sic] the present invention it is only necessary to use a removable storage device reader, either integrated into the server or external to the server, which can be used to upload the data to the server.” (‘797 Patent, 5: 8-16)

There is no basis for the Examiner’s argument that if the teachings of McGlothlin et al. were added to Kamper this would “increase ease of use.” In support, the Examiner cites the primary reference—Kamper—at column 5, line 65-column 6, line 5, which reads as follows:

“The smart card in accordance with a preferred embodiment of the present invention stores configuration data for one or more servers. The smart card can be configured with the configuration data prior to or subsequent to the physical setup of the server. Thus, the physical setup and the configuration of the device can be allocated to different personnel with different levels of technical expertise, security clearances, etc.”

This passage says nothing about the transfer of data relating to a GUI, nor does it have anything to do with “ease of use.” This language simply states that the smart card of Kamper may be used to transfer the IP address of the server, hostname, netmask, gateway, domain, or nameserver information based upon the level of technical expertise. There remains no teaching as to “ease of use,” the transfer of GUI information, or even the use of a display. There is no provision in McGlothlin et al. for “unique information relating to a particular user’s computer configuration preferences,” as specified in our claims. Therefore, there is no provision for any kind of user-specific data, including data files (such as Word documents or Excel spreadsheets) created by the user, and which are not part of the standard operating system load package.

In summary, both Kamper (6,654,797) and McGlothlin et al. (6,512,526) reside in systems for copying configuration information to multiple computers. In this sense, they are applicable primarily for use on an “assembly line” type of environment. Both systems describe a configuration process that occurs only at start-up (power-on) of the computer being configured. The user of these systems does

not determine the configuration information, nor have the option of including unique information, such as files created by the user. The user of these systems is, in effect, prohibited from updating the receiving system by adding, deleting, or providing new versions of existing files.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

In this case, the Examiner's argument that the proposed Kamper/McGlothlin is justified on "ease of use" grounds is not persuasive because the primary reference cannot be used by itself to import the teachings of a secondary reference. There is no factual evidence in support of the proposed combination, and even if the combination were proper, not all of Appellants' claim limitations would result. Appellants' claimed limitation as a whole includes the transfer of GUI information particular to specific user, a feature which the primary reference of Kamper teaches away from. Accordingly, *prima facie* obviousness has not been established.

B. Claim 11

Claim 11 stands rejected under 35 U.S.C. §103(a) over the Kamper/McGlothlin et al. combination as applied to claim 1, and further in view of U.S. Patent No. 6,029,196 to Lenz. Claim 11 adds to claim 1 the limitation that "user files stored on the storage medium are updated in accordance

with the use of the second computer.”

Claim 11 stands rejected under 35 U.S.C. §103 over Kamper as applied to claim 1, in view of Lenz ('196). The Examiner concedes that neither Kamper nor McGlothlin et al. “disclose files that are updated in accordance with the user at the second computer,” but argues that this would be obvious in that it would “alleviate the need for users to manually update their stored preferences and settings,” citing Lenz at column 1, lines 12-24. (Final OA, pp. 6-7)

However, the type of information transferred in accordance with the Kamper patent does not lend itself to user updating, since it is used for network configuration purposes across a broad range of server devices. As shown in Figure 4 of Kamper, the configuration data only is read in from the removable storage device if the computer, on booting-up, finds that the configuration has not already been installed at the designated storage location (Col. 6, ll. 22-26): “... the boot code of the server instructs the server to look for a configuration profile in a predetermined location in local memory storage. If a configuration profile exists, then the server is already configured and need not be configured using the removable storage device reader.” And (column 6, lines 30-33): “To change the profile, a user would have to clear or erase the current configuration profile stored in the server. The server would then boot-up with no configuration profile stored in the server.” At this point, the server would need to be powered-off and powered-on again, so that it then would find no configuration profile, and would load the configuration profile from the removable storage device reader.

Examiner states: “Lenz discloses a method for configuration of client preferences and settings in a computer environment, wherein updates to client files are used to replace existing files (column 2, lines 12-24).” (Final OA, top of p. 7). Implicit in this remark is the acknowledgement that the control of the configuration process lies at the remote, centralized location, rather than with the client. Further, it also carries the implication that the system is structured utilizing “client-server” architecture, which requires the existence of a centrally-located Server computer which serves multiple client computers over a specific network.

In a previous OA (mailed Nov. 5, 2004), the Examiner conceded that “Lenz does not teach the application of a transportable data medium to save user preferences and subsequently transferring those user-defined configurations to other computer systems.” Any combination that suggests that the control of the configuration process be removed to the user (client) location directly opposes the teachings and

purpose of Lenz:

“The invention provides an automatic client configuration system. The invention utilizes an efficient, easily managed and operated centralized configuration file system that allows the user to configure an entire network of clients from a centralized server.”

The automatic client configuration system provides the system administrator with the ability to configure every client in a network with one file. The file resides on the server and contains information for setting the client's lock files, e.g. preferences, configuration information, and software versions. Control over logical groupings of clients is possible using separate configuration files for each group.”¹ ('196 Patent, 1: 51-62)

and

“The centralized ability to maintain and query clients in a network eases the burden on the administrator of manually updating the software and other information on each client's machine.” ('196 Patent, 4:66-5:2)

In addition, all of the examples specify the use of a Server computer to serve as the source of the configuration files. The use of a Server is an obvious requirement of “Server-Client” architecture. In short, there is no motivation whatsoever to convert the system of Lenz to a system in which the control has been removed from the centralized management environment. An important aspect of Lenz is the need to limit the participation of clients to authorized members. Otherwise, any computer could connect to the network and download updates to commercial software that, while licensed to the authorized members, could not legally be made available to other clients in general.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

¹ In this context, as elsewhere in the disclosure, the word “user” refers to the user of the system disclosed - the System Administrator.

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Respectfully submitted,

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APPENDIX A
CLAIMS ON APPEAL

1. A method of transferring user preferences from one computer to another, comprising the steps of:

providing a transportable data storage medium;

recording on the transportable data storage medium, at a first computer, unique information relating to a particularly user's computer configuration preferences, including information relating to the user's preferred desktop graphical interface ;

receiving the transportable data storage medium at a second computer; and

at least temporarily configuring the second computer in accordance with the information stored on the transportable medium.

3. The method of claim 1, wherein storage medium includes information relating to wired or wireless network or dial-up communications preferences.

4. The method of claim 1, wherein storage medium includes information relating to one or more user files or information relating to a user file.

5. The method of claim 1, further includes the step of accessing a remote location to at least temporarily configuring the second computer in accordance with the information stored on the transportable medium.

6. The method of claim 5, wherein the remote location includes data or an application program desired by the user at the second computer.

7. The method of claim 1, wherein the step of at least temporarily configuring the second computer occurs through re-booting the second computer or through a different user log-on.

8. The method of claim 1, wherein storage medium uses a magnetic, optical, magneto-optical, or semiconductor memory.

9. The method of claim 1, wherein the user is prompted to retain the storage medium following the reconfiguration of second machine.

10. The method of claim 1, wherein the storage medium is in the form of a disk or card.

11. The method of claim 1, wherein user files stored on the storage medium are updated in accordance with the use of the second computer.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.